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FAX

Date:

February 27, 2003

Pages (including cover): 5

To:

Examiner Joseph T. Woitach

Fax: 1.703.305-3014

Ph: 1.703.305-3732

From:

Message:

Ronald I. Eisensetin

Applicants: Marasco et al.

FAX RECEIVED OFFICIAL FEB 28 2003

Appln. No.: 08/822,033

Filed: March 24, 1997

GROUP 1600

For: NUCLEIC ACID DELIVERY SYSTEM, METHODS OF SYNTHESIS AND USE

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this Request for Withdrawal of Finality is being transmitted via facsimile to the Office of Finance at the Patent and Trademark office on the date shown

Melissa Kruggel

Date: February 27, 2003

Date:

February 27, 2003

Pages (including cover): 5

To:

Examiner Joseph T. Woitach

Fax: 1.703.305-3014

Ph: 1.703.305.3732

From:

Ronald I. Eisenstein

Client/Matter:

700157-043471

User No.:

Disbursement Amount: \$



Practitioner's Docket N . 43471-RCE2

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Marasco et al.

Application No.:

08/822,033

Group No.: 1632

Filed:

03/24/1997

Examiner: Woitach, Joseph T.

For:

NUCLEIC ACID DELIVERY SYSTEM, METHODS OF SYNTHESIS AND

USE THEREOF

Commissioner for Patents and Trademarks Washington, D.C. 20231

REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION, OR IN THE ALTERNATIVE CONDITIONAL PETITION FOR WITHDRAWAL OF FINALITY

Applicants respectfully submit that the finality of the Office Action dated February 11, 2003 was improper and should be withdrawn, for the following reasons:

- On May 28, 2002, a Final Office Action was mailed in the parent application 1. (serial number 08/822,033, filed March 24, 1997).
- On October 28, 2002, applicants filed an Amendment after Final Rejection Under 2. 37 C.F.R. 111.6, and Petition or Extension of Time.
- On November 18, 2002, an Advisory Action (paper no. 40) was mailed, indicating 3. that the proposed Amendment would not be entered because it raised new issues that would further consideration and/or search [copy attached hereto].
- Accordingly, on November 26, 2002, applicants filed an RCE application, 4. including the previously submitted Amendment and the requisite fee.

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this Request for Withdrawal of Finality is being transmitted via facsimile to the Office of Finance at the Patent and Trademark office on the date shown below.

Melissa Kruggel

Date: February 27, 2003

- On February 11, 2003 in response to the filing the RCE, a Final Office Action was mailed, indicating that the application was eligible for continued examination under 37 C.F.R. 1.114, and that the proper fee had been paid. The Examiner entered the Amendment filed November 26, 2002, but made the Office Action "final".
- 6. MPEP 706.07(h), Section VIII, sets forth the conditions required for issuing a First Action Final After Filing an RCE, stating in relevant part: "The action immediately subsequent to the filing of an RCE with a submission and fee under 37 CFR 1.114 may be made final only if the conditions set forth in MPEP § [emphasis added]
- 7. MPEP § 706.07(b) explicitly states "it would not be proper to make final a first Office action in a continuing or substitute application where that material which was presented in the earlier application after final rejection ... was denied entry because (A) new issues were raised that required further consideration and/or search..." [emphasis added]
- 8. That is precisely the situation that has occurred here.
- 9. Accordingly, applicants respectfully submit that the finality of the Office Action dated February 11, 2003, was not proper, and respectfully request its withdrawal.
- 10. In the event that the Examiner does not grant this request to withdraw the finality of the Office Action, please consider this a Petition Under 37 CFR 1.181 to the Commissioner to withdraw finality due to prematureness of final rejection, MPEP § 706.07(c). (See MPEP § 1002(02)(c)(3)(a).) The Commissioner is authorized to charge any fee due in connection with this petition to Deposit Account No. 50-0850.
- Applicants believe no fee is due. However, please charge any required to Deposit Account No. 50-0850

Reg. No.: 30,628

Tel. No.: 617-345-6054

Customer No.: 26248

Ronald I. Eisenstein NIXON PEABODY LLP

101 Federal Street Boston, MA 02110



United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER OF PATENTS AND TRADEMARKS Westington, D.C. 20221

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APPLICATION NO.	FILING DATE	FIRST MANGE IN			
08/822,033	03/24/1997	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO. CONFIRMATION NO.		
		WAYNE A. MARASCO		CONFIRMATION NO.	
759	11/10/2002		43471-EWC RCE	5884	
Ronald I. Eisen	stein				
NIXON PEABODY LLP 101 Federal Street			EXAMINER		
Boston, MA 02110			WOITACH, JOSEPH T		
		•	ART UNIT	PAPER NUMBER	
			1632		
			DATE MAILED: 11/18/2002	J O	

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED
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NEXON PEABODY LLP

	Application No.	Applicant(s)	191	Micant's
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	Examiner		Art Unit	it al.
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The MAILING DATE of this communication applied THE REPLY FILED Nov 4, 2002 FAILS TO PLA	ears on the cover sheet wi	th the early		
Therefore, further action by the application FAILS TO PLA	CE THIS APPLICATION I	N CONDITION	pondence addre	\$8
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extension fee have been filed is the date for purposes of deter appropriate extension fee under 37 CFR 1.136(a). appropriate extension fee under 37 CFR 1.17(a) is calculated set in the final Office action; or (2) as set forth in (b) above, if mailing date of the final rejection, even if timely filed, may red	The date on which the petition rmining the period of extension from: (1) the expiration date checked. Any reply received	on under 37 Con and the corof the shortend by the Office	FR 1.136(a) and responding amound at attutory period	the appropriate of the fee. The propriet of the fee. The fee or include the fee or includ
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